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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,852	12/21/2000	Charles A. Eldering	T721-19	8089

27832 7590 03/29/2004

EXPANSE NETWORKS, INC.
6206 KELLERS CHURCH ROAD
PIPERSVILLE, PA 18947

EXAMINER

SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,852

Applicant(s)

ELDERING, CHARLES A.

Examiner

James Sheleheda

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-52 is/are rejected.
- 7) ☒ Claim(s) 4-8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2,3,4,5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: In claim 8, line 2, the word "defects" should be changed to --detects--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 9-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (Zigmond) (6,698,020) in view of Doherty (US2003/0200128A1).

As to claims 1 and 17, Zigmond discloses a subscriber system for inserting advertisements into at least one channel of media signals (Fig. 7; column 6, lines 4-12, column 10, lines 64-67 and column 11, lines 1-3), the system comprising:

an ad scheduler (or first means) (Fig. 5; ad insertion device, 80; wherein Fig. 5 is a detailed description of an insertion device used in Fig. 3) for identifying predetermined ad criteria (column 11, lines 50-53, column 11, lines 66-67 and column 12, lines 1-9) and the advertisement selection corresponding to that criteria (column 17, lines 24-28) which is to be inserted into the at least one channel (column 11, lines 42-49),

storing the criteria (column 11, lines 31-37 and column 17, lines 23-28) and advertisement selection corresponding to the identified criteria (column 11, lines 42-49), and

modifying the stored criteria whenever a modification requiring event occurs (column 12, lines 12-14 and column 13, lines 7-14); and

an ad insertion module (or second means) (Fig. 5; video switch, 90), coupled to the ad scheduler (contained in ad insertion device, 80), for inserting the advertisements into the at least one channel (column 10, lines 64-67 and column 11, lines 1-3) according to the stored criteria (column 15, lines 57-65).

Although Zigmond discloses the stored criteria and advertisement selection, he fails to specifically disclose an ordered listing of advertisements to be inserted based on this ordered listing.

In an analogous art, Doherty discloses a system for displaying targeted advertising (Fig. 1; paragraph 25, lines 1-6) wherein a scheduler (Fig. 1, 140) assembles a schedule (or ordered list; paragraph 29) of references pointing to advertisements (paragraph 28, lines 3-7 and paragraph 29), based upon advertisement priorities (paragraph 40), to determine the order in which advertisements are displayed (paragraph 38). A stored schedule would ensure that advertisements are properly prepared for output at their assigned times (paragraph 28, lines 1-11 and paragraph 38, lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include wherein a listing of the

order of advertisements to be inserted is stored and the advertisements are inserted based on this ordered listing, as taught by Doherty, for the typical advantage of ensuring that advertisements are properly prepared for output at their assigned times thereby promoting efficient advertisement delivery.

As to claim 33, Zigmond discloses a method of inserting advertisements into at least one channel of media signals using an advertisement insertion system (Fig. 7; column 6, lines 4-12, column 10, lines 64-67 and column 11, lines 1-3), the system comprising:

identifying predetermined ad criteria (column 11, lines 50-53, column 11, lines 66-67 and column 12, lines 1-9) and the advertisement selection corresponding to that criteria (column 17, lines 24-28) which is to be inserted into the at least one channel (column 11, lines 42-49);

storing the criteria (column 11, lines 31-37 and column 17, lines 23-28) and advertisement selection corresponding to the identified criteria (column 11, lines 42-49);

modifying the stored criteria whenever a modification requiring event occurs (column 12, lines 12-14 and column 13, lines 7-14); and

inserting the advertisements into the at least one channel (column 10, lines 64-67 and column 11, lines 1-3) according to the stored criteria (column 15, lines 57-65).

While Zigmond discloses the stored criteria and advertisement selection, he fails to specifically disclose an ordered listing of advertisements to be inserted based on this ordered listing.

In an analogous art, Doherty discloses a system for displaying targeted advertising (Fig. 1; paragraph 25, lines 1-6) wherein a scheduler (140) assembles a schedule (or ordered list; paragraph 29), based upon advertisement priorities (paragraph 40), to determine the order in which advertisements are displayed (paragraph 38). A stored schedule would ensure that advertisements are properly prepared for output at their assigned times (paragraph 28, lines 1-11 and paragraph 38, lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Zigmond's system to include wherein a listing of the order of advertisements to be inserted is stored and the advertisements are inserted based on this ordered listing, as taught by Doherty, for the typical advantage of ensuring that advertisements are properly prepared for output at their assigned times thereby promoting efficient advertisement delivery.

As to claim 2, Zigmond and Doherty disclose wherein the subscriber system is implemented using a set top box (see Zigmond at column 10, lines 22-25) and the at least one channel is a television program channel (see Zigmond at column 13, lines 29-32).

As to claim 3, Zigmond and Doherty disclose wherein the modification requiring event is at least one of or a combination of the following events: a channel change (see

Zigmond at column 9, lines 21-30 and lines 52-55) and a viewer change (see Zigmond at column 9, lines 56-62).

As to claim 9, Zigmond and Doherty disclose a storage unit (see Zigmond at column 11, lines 31-37 and column 12, lines 33-38), controlled by the ad scheduler (wherein it is contained within insertion device; see Zigmond at Fig. 5) for storing therein (see Zigmond at column 10, lines 25-35, column 11, lines 31-37 and column 12, lines 33-38) the ordered list (see Doherty at paragraph 29) in the form of a queue (wherein a listing of programs to be processed is, by definition, a queue).

As to claim 10, Zigmond and Doherty disclose wherein the ordered list in the storage unit is a stacked list of advertisement resource locators ("references"; see Doherty at paragraph 38, lines 9-12 and paragraph 28, lines 3-7) corresponding to locations where the advertisements are stored (see Doherty at paragraph 38, lines 9-12 and paragraph 28, lines 3-7).

As to claim 11, Zigmond and Doherty disclose wherein the order in the ordered list stored in the storage unit (see Doherty at paragraph 29) is dictated by tags included in the ARLs (wherein ad selection is dictated by specific criteria, or tags, for each ad; see Zigmond at column 11, lines 35-42).

As to claim 12, Zigmond and Doherty disclose wherein the tags identify the program being watched (wherein the criteria to choose an ad is based upon the current program being watched; see Zigmond at column 12, lines 47-53).

As to claim 13, Zigmond and Doherty disclose a receiving module, coupled to the ad insertion module (see Zigmond at Fig. 3; ad insertion module, 60; wherein Fig. 5 is a detailed description of an insertion device used in Fig. 3), for receiving the at least one channel from a communications network (wherein some receiver must be present to receiver the signal; see Zigmond at column 7, lines 12-21).

As to claim 14, Zigmond and Doherty disclose wherein the communications network is a television service network (see Zigmond at column 7, lines 16-21).

As to claim 15, Zigmond and Doherty disclose wherein the communications network is an Internet service network (see Zigmond at column 7, lines 16-21).

As to claim 16, Zigmond and Doherty disclose wherein the receiving module receives the at least one channel by one of the following means: digital broadcast satellite (see Zigmond at column 7, lines 16-21) or the Internet (see Zigmond at column 7, lines 16-21).

As to claim 18, Zigmond and Doherty disclose wherein the at least one channel is a television program channel (see Zigmond at column 13, lines 29-32).

As to claim 19, Zigmond and Doherty disclose wherein the modification requiring event is at least one of or a combination of the following events: a channel change (see Zigmond at column 9, lines 21-30 and lines 52-55) and a viewer change (see Zigmond at column 9, lines 56-62).

As to claim 20, Zigmond and Doherty disclose a third means (ad insertion device, 60), coupled to the first means (wherein it is contained in the same device), for detecting an occurrence of the modification requiring event (wherein the specific user actions are monitored; see Zigmond at column 9, lines 21-30), and outputting results of the detection to the first means (see Zigmond at column 9, lines 52-55 and column 10, lines 40-47), so that the first means modifies the stored ordered list based on the results of the detection (see Zigmond at column 9, lines 52-55 and column 10, lines 40-47).

As to claim 21, Zigmond and Doherty disclose a channel selection device (used to change the viewed channel; see Zigmond at column 9, lines 21-30), coupled to the third means, for selecting a program channel for viewing by a viewer (see Zigmond at column 9, lines 21-30), wherein the third means detects the channel change based on outputs from the channel selection device (see Zigmond at column 9, lines 21-30).

As to claim 22, Zigmond and Doherty disclose wherein the third means detects the viewer change using prestored viewer profile information (see Zigmond at column 9, lines 65-67 and column 10, lines 1-3).

As to claim 23, Zigmond and Doherty disclose wherein the third means detects the viewer change (column 9, lines 56-59, lines 65-67 and column 10, lines 1-3) using the following information stored in the prestored viewer profile (column 11, lines 13-18 and column 12, lines 34-38): time-of-day information for each viewer in a subscriber household (column 11, lines 13-18)

As to claim 24, Zigmond and Doherty disclose a channel selection device (used to change the viewed channel; see Zigmond at column 9, lines 21-30), coupled to the third means for selecting a program channel for viewing by a viewer (see Zigmond at column 9, lines 21-30), wherein the third means detects the change in type of program being watched based on outputs from the channel selection device (wherein the ad is based upon the user selection; column 17, lines 21-28) and program information (column 12, lines 60-67 and column 13, lines 1-6).

As to claim 25, Zigmond and Doherty disclose wherein the first means includes a memory (see Zigmond at column 11, lines 31-37 and column 12, lines 33-38) for storing (see Zigmond at column 10, lines 25-35, column 11, lines 31-37 and column 12, lines

33-38) the ordered list (see Doherty, paragraph 29) in the form of a queue (wherein a listing of programs to be processed is, by definition, a queue).

As to claim 26, Zigmond and Doherty disclose wherein the ordered list stored in the memory is a stacked list of advertisement resource locators (references; see Doherty at paragraph 38, lines 9-12 and paragraph 28, lines 3-7) corresponding to locations where the advertisements are stored (see Doherty at paragraph 38, lines 9-12 and paragraph 28, lines 3-7).

As to claim 27, Zigmond and Doherty disclose wherein the order in the ordered list stored in the memory (see Doherty at paragraph 29) is dictated by tags included in the ARLs (wherein ad selection is dictated by specific criteria, or tags, for each ad; see Zigmond at column 11, lines 35-42).

As to claim 28, Zigmond and Doherty disclose wherein the tags identify the program being watched (wherein the criteria to choose an ad is based upon the current program being watched; column 12, lines 47-53).

As to claim 29, Zigmond and Doherty disclose an inherent fourth means, coupled to the second means (see Zigmond at Fig. 3; ad insertion module, 60), for receiving the at least one channel from a communications network (wherein some receiver must be present to receive the signal; see Zigmond at column 7, lines 12-21).

As to claim 30, Zigmond and Doherty disclose wherein the communications network is a television service network (see Zigmond at column 7, lines 16-21).

As to claim 31, Zigmond and Doherty disclose wherein the communications network is an Internet service network (see Zigmond at column 7, lines 16-21).

As to claim 32, Zigmond and Doherty disclose wherein the fourth means receives the at least one channel by one of the following means: digital broadcast satellite (see Zigmond at column 7, lines 16-21) or the Internet (see Zigmond at column 7, lines 16-21).

As to claim 34, Zigmond and Doherty disclose wherein the at least one channel is a television program channel (see Zigmond at column 13, lines 29-32).

As to claim 35, Zigmond and Doherty disclose where, in the modifying step, the modification requiring event is at least one of or a combination of the following events: a channel change (see Zigmond at column 9, lines 21-30 and lines 52-55) and a viewer change (see Zigmond at column 9, lines 56-62).

As to claim 36, Zigmond and Doherty disclose wherein the modifying step includes: detecting an occurrence of the modification requiring event (wherein the

specific user actions are monitored; see Zigmond at column 9, lines 21-30); and modifying the stored ordered list (see Doherty at paragraph 29; containing selection criteria for each ad; see Zigmond at column 11, lines 35-42) based on the results of the detecting step (see Zigmond at column 9, lines 52-55 and column 10, lines 40-47).

As to claim 37, Zigmond and Doherty disclose wherein, in the detecting step, the channel change is detected based on outputs from a channel selection device coupled to the advertisement insertion system (see Zigmond at column 9, lines 21-30).

As to claim 38, Zigmond and Doherty disclose wherein, in the detecting step, the viewer change is detected using prestored viewer profile information (see Zigmond at column 9, lines 65-67 and column 10, lines 1-3).

As to claim 39, Zigmond and Doherty disclose the viewer change is detected (column 9, lines 56-59, lines 65-67 and column 10, lines 1-3) using the following information stored in the prestored viewer profile (column 11, lines 13-18 and column 12, lines 34-38): time-of-day information for each viewer (column 11, lines 13-18).

As to claim 40, Zigmond and Doherty disclose wherein in the detecting step, the change in the type of program being watched is detected based on outputs from a channel selection device coupled to the advertisement insertion system (wherein the ad

is based upon the user selection; column 17, lines 21-28) and program information (column 12, lines 60-67 and column 13, lines 1-6).

As to claim 41, Zigmond and Doherty disclose wherein, in the storing step (see Zigmond at column 11, lines 31-37 and column 12, lines 33-38), the ordered list (see Doherty, paragraph 29) is stored in a queue (wherein a listing of programs to be processed is, by definition, a queue) in a memory (see Zigmond at column 10, lines 25-35, column 11, lines 31-37 and column 12, lines 33-38) accessible by the advertisement insertion system (wherein it is contained within insertion device; see Zigmond at Fig. 5).

As to claim 42, Zigmond and Doherty disclose wherein the ordered list stored in the queue is a stacked list of advertisement resource locators ("references"; see Doherty at paragraph 38, lines 9-12 and paragraph 28, lines 3-7) corresponding to locations where the advertisements are stored (see Doherty at paragraph 38, lines 9-12 and paragraph 28, lines 3-7).

As to claim 43, Zigmond and Doherty disclose wherein the order in the ordered list stored in the queue (see Doherty at paragraph 29) is dictated by tags included in the ARLs (wherein ad selection is dictated by specific criteria, or tags, for each ad; see Zigmond at column 11, lines 35-42).

As to claim 44, Zigmond and Doherty disclose wherein the tags identify the program being watched (wherein the criteria choose an ad based upon the current program being watched; column 12, lines 47-53).

As to claim 45, Zigmond and Doherty disclose prior to the inserting step (see Zigmond at column 7, lines 12-21), receiving the at least one channel from a communications network (see Zigmond at column 7, lines 12-21).

As to claim 46, Zigmond and Doherty disclose wherein the communications network is a television service network (see Zigmond at column 7, lines 16-21).

As to claim 47, Zigmond and Doherty disclose wherein the communications network is an Internet service network (see Zigmond at column 7, lines 16-21).

As to claim 48, Zigmond and Doherty disclose wherein, in the receiving step, the at least one channel is received by one of the following means: digital broadcast satellite (see Zigmond at column 7, lines 16-21) or the Internet (see Zigmond at column 7, lines 16-21).

As to claim 49, Zigmond and Doherty disclose wherein the ordered list (see Doherty at paragraph 29) identifies one or more linked advertising parameters (wherein ad selection is dictated by specific criteria for each ad; see Zigmond at column 11, lines

35-42) for providing linked advertising (wherein the stored criteria hold information linking advertisements to ratings or times; see Zigmond at column 13, lines 48-67).

As to claim 50, Zigmond and Doherty disclose wherein the linked advertising parameters identify at least one of time dependence (see Zigmond at column 13, lines 59-67) and viewer dependence of advertisements (see Zigmond at column 14, lines 49-58).

As to claim 51, Zigmond and Doherty disclose wherein the ordered list (see Doherty at paragraph 29) identifies one or more linked advertising parameters (wherein ad selection is dictated by specific criteria for each ad; see Zigmond at column 11, lines 35-42) for providing linked advertising (wherein the stored criteria hold information linking advertisements to ratings or times; see Zigmond at column 13, lines 48-67).

As to claim 52, Zigmond and Doherty disclose wherein the linked advertising parameters identify at least one of time dependence (see Zigmond at column 13, lines 59-67) and viewer dependence of advertisements (see Zigmond at column 14, lines 49-58).

Allowable Subject Matter

Art Unit: 2614

4. Claims 4-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2614

JS


CHRIS GRANT
PRIMARY EXAMINER